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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/760,943	01/20/2004	John Eliason	9359-2CT	1267

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EXAMINER

GALL, LLOYD A

ART UNIT PAPER NUMBER

3676

DATE MAILED: 07/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/760,943	Applicant(s) ELLIASON, JOHN	
	Examiner Lloyd A. Gall	Art Unit 3676	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

The disclosure is objected to because of the following informalities: On page 1, the status of the parent application should be updated.

Appropriate correction is required.

Claims 1 and 10 are objected to because of the following informalities: In the last line of claim 1, "position" should be replaced with --direction--. In claim 10, line 2, "key assembly" should be replaced with --engagement assembly--. Appropriate correction is required.

Claims 1-3 and 7-16 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-33 of U.S. Patent No. 6,701,760. Although the conflicting claims are not identical, they are not patentably distinct from each other because they substantially claim the same subject matter, and the claimed limitations of claims 1-3 and 7-16 of the instant application are claimed in claims 1-33 of US Patent No. 6,701,760.

Claims 4-6 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-33 of U.S. Patent No. 6,701,760 in view of Mazzola. Mazzola teaches plural set screws 46 to frictionally hold a key. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the screw of claim 13 of US Patent No. 6,701,760 to include plural screws to frictionally hold the key, in view of the teaching of Mazzola, the motivation

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being to optimize the strength of the connection between the engagement assembly and the key.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 17 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Von Hunefeld.

Von Hunefeld teaches a tool for remotely turning a key, including a key unit 1-5 in figures 3 and 4, an operator unit including a control assembly defined by the bottommost knot as seen in figure 4 below the key unit 1-5, cable segments extending to the left and right of the operator knot to rotate the key in opposite directions by pulling the cable segments with the operator knot. The method limitations of claims 17 and 18 are inherent in the teachings of Von Hunefeld.

Claims 1, 17 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Upton.

Upton teaches a tool for remotely turning a switch "key" 2, including an engagement assembly 4, 6 to engage the key, an operator unit including a control assembly 13, 14, first and second cable segments 10, 11 which are pulled by the control assembly to rotate the key 2. The method limitations of claims 17 and 18 are inherent in the teachings of Upton.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lankford in view of Mazzola.

Lankford teaches a tool for remotely turning a key, including a key unit comprising an engagement assembly 23, 26, an operator unit comprising a control assembly defined by the loop 33 in figure 1, and a cable segment 32 to be pulled to rotate the key.

Mazzola teaches plural screws 46 to frictionally engage a key. It would have been obvious to one of ordinary skill in the art at the time the invention was made to frictionally engage the key of Lankford with plural screws, in view of the teaching of Mazzola, the motivation being to optimize the strength of the connection between the engagement assembly and the key.

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Von Hunefeld in view of Lankford.

Both of the references have been discussed above. In addition, Lankford teaches using the key with an ignition of a vehicle. It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the tool of Von Hunefeld with a vehicle ignition, in view of the teaching of Lankford, the motivation being to be able to actuate the ignition with servicing a vehicle.

Provided the above double patenting rejections are overcome, claims 2, 3 and 7-16 would be allowable.

The following is a statement of the examiner's Reasons For Allowance: The examiner has adopted the positions set forth by applicant with respect to claims 2, 3 and 7-16 in the RESPONSE TO OFFICE ACTION ISSUED IN PARENT APPLICATION.

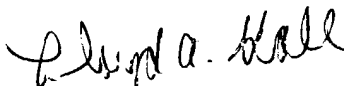
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lloyd A. Gall whose telephone number is 703-308-0828. The examiner can normally be reached on Monday-Friday, 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on 703-308-2151. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LG LG
July 9, 2004


Lloyd A. Gall
Primary Examiner